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10/696,583

10/30/2003

William J. Farrell JR.

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WASHINGTON, DC 20036

EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/696,583

Applicant(s)

FARRELL ET AL.

Examiner

William V. Gilbert

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3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>02/08/07; 10/12/05; 07/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a First Action on the Merits. Claims 14-20 are withdrawn from consideration. Claims 1-13 are examined below.

Election/Restrictions

1. Applicant's election without traverse of Claims 1-13 in the reply filed on 22 February 2007 is acknowledged.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because **Figures 1-6 and 11-18** are pictures which are unclear to the Examiner. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

3. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

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A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n). This applies to **Claims 10-13** which are not in the proper order.

Claim 1 is objected to because of the following informalities: line 5 error. Examiner suggests delete "side.." insert --side.--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims "a gap on each side" line 5, but it is unclear to what "each side" is (e.g. each side of which limitation.)

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Claim 5 recites the limitation "said V-shaped impressions" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rockstead (U.S. Patent No. 4,104,842).

Claim 1: Rockstead discloses a panel having first and second wire mesh members (Fig 4: 11 and 12), a screed means (18 at the apex) and a middle member (13) between the first and second members to define a gap.

Claim 2: the phrase "adapted to accept...panel" line 2 is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 6: at least two parallel V-shaped impressions are on at least one wire mesh member.

Claim 8: the wire mesh members are secured to the middle member.

Claim 10: an outer layer (Fig. 5: 34) on one side of the panel is cut flat using the V-shaped impressions as a screed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockstead in view of Chen (U.S. Patent No. 4,611,450).

Claim 3: Rockstead discloses the claimed invention except that the middle member is a plurality of layers having wire trusses and polystyrene foam. Chen discloses a panel where the middle member (211, 212) is a plurality of layers (212) and trusses (211) and the foam is polystyrene. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a plurality of layers for the middle member to aid in the ease of preassembly of the panel and polystyrene foam is functionally equivalent to the foam in Rockstead and would perform equally as well.

Claim 4: Rockstead discloses the claimed invention including that the middle member is in a compressed state (Fig. 5: the outer layer would put the foam in compressions), but Rockstead does not disclose the compression is 2.5 inches. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to compress to this

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degree as a matter of design choice because Applicant did not state a criticality for the necessity of this limitation and the prior art of record is capable of being compressed in such a manner. The phrase, "secured by a clamp means...wire mesh members", lines 2, 3 are method steps and only the final product, the panel is considered.

Claim 5: Rockstead discloses the claimed invention except for the dimensions prior to and after the release of the clamp. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these dimensions because Applicant failed to state a criticality for the necessity of these limitations and the prior art of record is capable of conforming to the limitations.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rockstead in view of Salisbury (U.S. Patent No. 4,660,342).

Claim 9: Rockstead discloses the claimed invention including that the panels have hog rings associated with them (Col. 3, lines 42-44), but Rockstead does not disclose a z-clip. Salisbury discloses a z-clip (Fig. 10) with oppositely orientated arms (77, 83), attaching the panel to a wall (Fig.

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9). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a clip with the panel in Rockstead because the panel in Rockstead is attached to the wall and the z-clip in Salisbury is capable of performing as desired with the panel in Rockstead.

Claims 7, 11, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockstead.

Claim 7: Rockstead discloses the claimed invention except that the screed is clipped-on. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the screed separable because courts have held that making a limitation separable is within the level of ordinary skill in the art. M.P.E.P §2144.04 citing *In re Dulbert*, 289 F.2d 522.

Claim 11: an outer layer (Fig. 5: 34) on one side of the panel is cut flat using the V-shaped impressions as a screed.

Claims 12 and 13: Rockstead discloses the claimed invention except for the dimensions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these dimensions because Applicant failed to state a criticality for the

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necessity of these dimensions and the prior art of record is capable of meeting these limitations.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stanley (U.S. Patent No. 290,133; Sacks (U.S. Patent No. 6,820,387); Baumann (U.S. Patent No. 3,407,560); Mills (U.S. Patent No. 2,669,114).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571.272.6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Paul A. De
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